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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,171	05/23/2000	Kia Silverbrook	NPX014US	9202

24011 7590 03/03/2003

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

HESELTIME, RYAN J

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,171

Applicant(s)

SILVERBROOK ET AL.

Examiner

Ryan J Hesseltine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-81 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed March 7, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. This is in reference to USPN 5,051,736 to Bennett et al., and USPN 5,692,073 to Cass, for which copies were not received.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "one or more motion sensing elements rotatably mounted to the sensing device" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

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4. Claim 39 is objected to because of the following informalities: line 1 states, "A system according to any one of claims 33 to 28," it is believed that applicant intended this to state, "any one of claims 33 to 38." Appropriate correction is required.

5. Claims 17 and 41 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

6. Applicant is advised that should claim 33 be found allowable, claim 65 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 21-24, 53-56, and 77 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no illustration in the drawings or detailed discussion in the specification of "one or more motion sensing elements rotatably mounted to the sensing device for contact with the surface while the sensing device is used to sign the signature thereon."

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 33 and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 33 and 65 each claim subject matter directed to both a system and the method of using that system. Lines 1-8 of claim 33 is directed to the system, while lines 9-14 is directed to the method steps performed by the system. In claim 65, lines 1-6 is directed to the system, while lines 7-16 is directed to the method steps performed by that system. Claim 1, which claims the method, also has structural limitations, but lines 1-8 are considered to be preamble to the method steps in lines 9-14.

11. Claims 18, 47, 50, and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 18, 47, 50, and 76 recite the limitation "sensing means." There is insufficient antecedent basis for this limitation in these claims, and is inconsistent with the previous references to a "sensing device."

12. Claim 74 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 74 recites the limitation "relative displacement" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 2, 33, 34, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur (USPN 5,852,434) in view of Hilton (USPN 5,107,541).

15. Regarding claims 1, 33, and 65, Sekendur discloses a system and method of enabling user interaction with computer software running in a computer system (column 5, line 1-14) via: an interface surface containing information relating to the computer software and including coded data (column 5, line 22-30), and a sensing device (figure 6, element 8) which, when placed in an operative position relative to the interface surface, senses indicating data and generates movement data (column 2, line 44-47) indicative of the sensing device's movement (path) (column 5, line 40-45); the method including the steps of, in the computer system: (a) receiving the indicating data from the sensing device (column 5, line 5-14); (b) receiving the movement data from the sensing device (column 5, line 42-45); (c) identifying the writing surface on the basis of the indicating data (column 5, line 40-42); and (d) operating the computer software at least partly in reliance on the movement data (column 6, line 46-50), and in accordance with instructions associated with writing surface (column 5, line 60-62).

16. Sekendur discloses that the movement data indicative of the sensing device's movement can be used for signature verification (column 3, line 38-39), but does not explicitly disclose that the coded data is indicative of a signature field relating to the computer software. Hilton discloses a method and apparatus for capturing information in drawing or writing wherein a paper check (figure 4, element 12) is placed on the scanning surface (27) and the check is signed over lines (indicating data, 13) while the static and dynamic features (movement data) of the signature are recorded by the detector (11) within the pen (column 5, line 16-21). It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to include coded data indicative of a signature field as taught by Hilton in order to allow a user to verify or authenticate a document or action such as a bank transaction such that the signature area is detected as the user is signing the document.

17. Regarding claims 2, 34, and 66, Sekendur discloses that the system and method includes verifying that the movement data represents a handwritten signature of the user (column 3, line 38-39).

18. Claims 3-7, 25-27, 29, 30, 35-39, 57-59, 61, 62, 67-70, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Hilton as applied to claims 1, 33, and 65 above, and further in view of Marshall (USPN 5,774,571).

19. Regarding claims 3 and 35, Sekendur discloses that the movement data can be used for signature verification, but does not explicitly disclose that the user is identified in this manner. Marshall discloses a writing instrument with multiple sensors for biometric verification wherein the user is identified (column 7, line 31-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to identify the user as taught by Marshall in order to verify that the person writing the signature with the writing instrument is the correct person.

20. Regarding claims 4, 36, and 67, Marshall discloses that identifying the user includes using the movement data (column 7, line 28-36).

21. Regarding claims 5, 37, and 68, Marshall discloses that the system and method are configured to receive data indicative of the identity of the user (column 7, line 60-65).

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22. Regarding claims 6, 38, and 69, Marshall discloses that the system and method are configured to receive data from storage means (sub-memory means) of the sensing device, the data being indicative of the identity of the user (column 6, line 55-61; column 7, line 60-65).

23. Regarding claims 7, 39, and 70, Hilton discloses that the system and method are configured to use a signature key (codeword) of the user to generate a digital signature of digital content related to the computer software (column 9, line 14-31).

24. Regarding claims 25, 57, and 78, Sekendur discloses that the coded data includes at least one tag, each tag being indicative of the signature field (writing surface) (figure 3; column 5, line 40-45).

25. Regarding claims 26 and 58, Sekendur discloses that the tags are also indicative of points within the signature field (writing surface) (figure 3; column 5, line 40-45).

26. Regarding claims 27 and 59, Sekendur discloses that each of the tags includes: first identity data defining a relative position (coordinates) of that tag; and second identity data identifying the signature field (writing surface) (figure 3; column 5, line 40-45).

27. Regarding claims 29 and 61, Sekendur does not explicitly disclose that the relative position is defined in relation to a plurality of the other tags, but does disclose that triangulation may be used to determine the path of the stylus, which requires using a plurality of points, or tags (column 5, line 40-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the relative position in relation to a plurality of tags as taught by Sekendur in order to determine the path of the stylus without using absolute positioning.

28. Regarding claims 30 and 62, Sekendur discloses the relative position is defined in relation to the interface surface (column 5, line 22-30).

29. Claims 8-10 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Hilton in view of Marshall as applied to claims 7 and 39 above, and further in view of Zank et al. (USPN 6,307,955), hereafter Zank.

30. Regarding claims 8 and 40, Sekendur does not disclose generating a digital signature by encrypting the signature using a fixed-length hash. Zank discloses an electronic signature management system that is configured to generate a hash (column 6, line 55-58) based on the digital content (column 6, line 26-31) and to encrypt the hash in accordance with the signature key after the signature has been verified (column 7, line 26-29), thereby to generate the digital signature (column 7, line 45-50). Zank does not explicitly disclose that the hash is of fixed length, but it would have been obvious to make the hash of fixed length in order to standardize the encryption step. It would have been obvious to one of ordinary skill in the art at the time the invention was made to generate a digital signature as taught by Zank in order to allow a user to verify an electronic document (column 7, line 51-59).

31. Regarding claims 9 and 41, Zank discloses that the digital content is provided by the user (column 8, line 44-50).

32. Regarding claims 10 and 42, Zank discloses that the digital content is based on data input by the user via the sensing device and interface surface (column 8, line 44-50).

33. Claims 11-13, 43-45, 71, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Hilton in view of Marshall as applied to claims 1-7, 33-39, and 65-70 above, and further in view of Cox (USPN 5,199,068).

34. Regarding claims 11, 43, and 71, Sekendur, Hilton, nor Marshall discloses that a digital signature is associated with the signature field. Cox discloses a computer-based training system

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with student verification wherein the system and method are configured to associate the digital signature (column 4, line 11-17) with the signature field (column 3, line 45-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to associate the digital signature with the signature field as taught by Cox in order to provide a space for the user to sign and to view the signature on a computer monitor for verification.

35. Regarding claims 12 and 44, Cox discloses that the computer system is configured to send data to the computer software indicative of at least the signature field (column 3, line 45-47).

36. Regarding claims 13, 45, and 72, Cox discloses that the signature field is associated with a visible signature zone (figure 3, element 24) defined on the interface surface (column 3, line 23-31).

37. Claims 14-19, 21, 22, 46-51, 53, 54, and 73-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Hilton in view of Marshall as applied to claims 1-6, 33-38, and 65-67 above, and further in view of Wolff et al. (GB 2,306,669), hereafter Wolff.

38. Regarding claims 14, 46, and 73, Sekendur, Hilton, nor Marshall explicitly discloses that the sensing device includes at least one acceleration-measuring device. Wolff discloses a manual entry interactive paper and electronic document handling and processing system wherein the sensing device includes at least one acceleration measuring device for measuring acceleration of the sensing device as it is used to sign the signature onto the surface (page 17, line 13-22), the movement data being generated by periodically sampling the acceleration of the sensing device as it is used to sign the signature onto the surface (page 21, line 6-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include at least

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one acceleration-measuring device in the sensing device as taught by Wolff in order to obtain movement data of the sensing device in the form of acceleration signals.

39. Regarding claims 15 and 47, Wolff discloses that the system and method further includes the step of generating movement data in the form of a locus of the sensing means in relation to the surface (page 13, line 13-21), the locus being determined by ascertaining relative displacement (position) of the sensing device (page 17, line 20-22).

40. Regarding claims 16, 48, and 74, Wolff discloses that the relative displacement is obtained by doubly integrating the acceleration with respect to time (page 18, line 1-2).

41. Regarding claims 17, 49, and 75, Wolff discloses that the acceleration-measuring device includes one or more accelerometers (page 18, line 1-2) configured to measure at least two orthogonal components (two of three attitude planes) of acceleration (page 17, line 16-18).

42. Regarding claims 18 and 50, Wolff discloses that position elements are disposed on the interface surface (pre-printed marks), the sensing device being configured to periodically sense position elements as it is used to draw onto the surface (page 22, line 5-7), including the step of generating the movement data by ascertaining relative displacement of the sensing means over time with respect to at least one of the position elements (page 18, line 2-7).

43. Regarding claim 76, Wolff discloses that the position elements are disposed on the interface surface, the sensing device being configured to periodically sense position elements as it is used to sign the signature onto the surface, the movement data being generated in the form of a locus of the sensing means in relation to the surface by ascertaining relative displacement of the sensing means with respect to at least one of the position elements (see discussion of claims 15, 18, 47, and 50 above).

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44. Regarding claims 19 and 51, Sekendur discloses that the position elements are disposed on the surface as a regular array of dots, lines or other formations (figure 1, element 2; column 5, line 1-5).

45. Regarding claims 21, 53, and 77, Sekendur does not disclose that the movement data is generated using one or more motion sensing elements rotatably mounted to the sensing device. Wolff discloses that the movement data is generated by ascertaining relative rotation of one or more motion sensing elements (gyroscopes) rotatably mounted to the sensing device for contact with the surface while the sensing device is used to sign the signature thereon (page 17, line 13-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to generate movement data using one or more rotatably mounted motion sensors as taught by Wolff in order to determine the motion and relative position of the sensing device in two of three attitude planes based on the measured angular velocity.

46. Regarding claims 22 and 54, Sekendur does not disclose that the motion sensing elements include one or more rollerballs. Marshall discloses that the motion sensing elements include one or more rollerballs (figures 8 and 9, elements 46) mounted for rotation within a constraining housing disposed substantially within the sensing device (column 11, line 24-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use rollerballs as the motion sensing elements as taught by Marshall in order to enable a totally free standing writing instrument to execute its own direction calculations (column 11, line 30-40).

47. Regarding claim 78, see discussion of claims 25 and 57 above. Regarding claim 79, see discussion of claims 26 and 58 above. Regarding claim 80, see discussion of claims 27 and 59 above.

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48. Claims 20 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Hilton in view of Marshall in view of Wolff as applied to claims 18 and 50 above, and further in view of Dymetman et al. (USPN 6,330,976), hereafter Dymetman. Sekendur does not disclose that the position elements are disposed on the surface stochastically. Dymetman discloses a marking medium area with encoded identifier for producing action through network including a coded substrate (column 8, line 55-67) wherein the visible or invisible markings are disposed (created) stochastically using a random number generator (column 32, line 54-58).

49. Claims 23, 24, 55, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Hilton in view of Marshall in view of Wolff as applied to claims 22 and 54 above, and further in view of Chang (USPN 5,298,919).

50. Regarding claims 23 and 55, Marshall does not explicitly disclose that components of rotation of the roller ball are periodically measured. Chang discloses a multi-dimensional input device including roller balls (column 4, line 38-41) and sensors which sample and measure movement of the roller balls (column 4, line 60-63) at a fixed frequency (column 7, line 16-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to periodically measure the components of rotation of the roller balls as taught by Chang in order to synchronize the measurements with the system computer (column 7, line 23-32).

51. Regarding claims 24 and 56, Marshall discloses that the components of rotation of the roller ball due to movement of the sensing device by the user when signing the signature onto the surface are measured by means of: rollers (electrical contacts or sensors) disposed within the constraining housing for rotation, the rollers (sensors) being configured to be driven by contact

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with the rotating roller ball (column 11, line 24-27). Chang discloses that the components of rotation of the roller ball may be measured by means of optical sensing of rotation of the roller ball with respect to the constraining housing (column 4, line 65-68).

52. Claims 28 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Hilton in view of Marshall as applied to claims 27 and 59 above, and further in view of Zank. Sekendur does not disclose that the relative position is defined in relation to the signature field. Zank discloses that x- and y-axis data can be absolute, relative, or incremental, where relative is with respect to a starting point of a signature (column 5, line 66 to column 6, line 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the relative position in relation to the signature field as taught by Zank in order to simplify calculations by not keeping track of the absolute position in relation to the interface surface origin.

53. Claims 31 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Hilton in view of Marshall as applied to claims 27 and 59 above, and further in view of Dymetman. Sekendur does not disclose that the first identity data identifies stored information defining the relative position, the stored information not being stored on the interface surface. Dymetman discloses a marking medium area with encoded identifier for producing action through network including first identity data that identifies stored information defining the relative position (locations or zones within the substrate) (column 8, line 63-67), the stored information not being stored on the interface surface (first identifier includes a second identifier accessible by table or other data structure) (column 7, line 29-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to identify

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information not stored on the interface surface using the first identity data as taught by Dymetman in order to provide additional information related to the first identity data.

54. Claims 32 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Hilton in view of Marshall as applied to claims 31 and 61 above, and further in view of Dymetman. Dymetman discloses that the first identity data and the second identity data together identify stored information defining the relative position (column 7, line 29-35).

Conclusion

55. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,294,792 to Lewis et al. discloses a writing tip position sensing and processing apparatus. USPN 5,781,661 to Hiraiwa et al. discloses a handwriting information detecting method and apparatus detachably holding writing tool. USPN 5,120,906 to Protheroe et al. discloses a handwriting capture device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J Hesseltine whose telephone number is 703-306-4069. The examiner can normally be reached on Monday - Friday, 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

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February 24, 2003



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